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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/538,477	06/07/2005	Chih-Chang Chu	CHUC3007	2280

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EXAMINER	
HAIDER, SAIRA BANO	

ART UNIT	PAPER NUMBER
1796	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/538,477	CHU ET AL.	
	Examiner	Art Unit	
	SAIRA HAIDER	1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 January 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 3-7* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 and 3-7* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ekman et al. (US 4,822,535) in view of Moiser (US 4,492,720), and in view of Jahns (US 5,596,051).

3. Ekman discloses method of producing small spherical polymer particles from systems containing two liquid phases, the one phase of which contains one or more dissolved substances and is dispersed in the form of small droplets in the other phase to form an emulsion, whereafter the droplets are converted to a solid form. The liquid phases used are two mutually immiscible aqueous phases (abstract). Ekman notes that whole (living) cells, cell organelles, solid particles or small oil droplets can be encapsulated when practicing the invention (col. 8, lines 15-17).

4. In example 6, Ekman discloses the preparation of spherical particles of cross-liked dextran. The process involves preparing a first aqueous solution of acryldextran (M_w=40,000). Ekman discloses that acryldextran which functions as both the monomer and a crosslinker. Next, a second aqueous solution is then prepared from polyethylene glycol (M_w=6,000). The first aqueous solution is added to the second aqueous solution and emulsified, wherein the first aqueous solution is the inner phase (the droplets). Polymerization is initiated via a catalyst. The particles are collected via filtration.

5. Ekman fails to explicitly disclose the size of the droplets; however Ekman notes that the particle size of the solid particles obtained can be controlled in all of the disclosed embodiments in a manner known per se, for example by stirring with varying intensities or by selecting suitable viscosities for the various phases. In the case of the system polyethylene glycol-starch the particle

size can also be regulated by selection of the molecular weight of the polyethylene glycol, a polyethylene glycol of higher molecular weight providing larger particles (col. 7, lines 66 to col. 8, lines 4). Thus attention is directed to the Moiser reference, which discloses a method of preparing microspheres for intravascular delivery. Specifically, Moiser creates the microspheres via formation of an emulsion of two phases, wherein the droplets that comprise the dispersed phase have average sizes in the range of 50-150 microns (col. 4, lines 3-26). Wherein the resulting microspheres are in the range of 50-350 microns and are rendered suitable for administration of therapeutic agents and diagnostic agents via intra-arterial delivery (col. 1, lines 49-59). Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to alter the Ekman process conditions (as taught by Ekman) in order to form droplets and resulting microcapsules suitable for intra-arterial delivery, as taught by Moiser.

6. Ekman applies as above and notes that polyethylene glycol is preferably the continuous phase (col. 3, lines 19-24); however Ekman discloses that suitable two-phase systems of polymeric aqueous solutions include dextran/polyethylene glycol/water and polyethylene glycol/dextran sulphate/water (col. 1, line 66 to col. 2, line 19). Accordingly, it is readily envisaged that polyethylene glycol is the dispersed phase and dextran is the continuous phase.

7. It is noted that Ekman discloses polyethylene glycol as the dispersed phase, but fails to disclose the claimed polyethylene glycol diacrylate, as claimed. Thus attention is directed to the Jahns reference, which discloses the formation of microcapsules which may contain drugs and enzymes as the core material (abstract; col. 4, limes 21-22). Specifically, Jahns discloses polyethylene glycol diacrylate as suitable crosslinking monomers for the microcapsule shell (col. 3, lines 5-11). Jahns recognizes that such crosslinking monomers swells the microcapsule such that the core material can be released over a longer period of time (col. 3, lines 26-39). Further it is noted that Ekman prefers

polyethylene glycol having a molecular weight of 6,000 and prefers the usage of crosslinking monomers for the dispersed phase (Example 6). Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize poly(ethylene glycol) diacrylate having a polyethylene glycol with a molecular weight of 6,000 as the dispersed phased in the hydrogel formation process taught by Ekman and Moiser in order to forma sustained release microcapsule.

8. Claims 3-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ekman et al. (US 4,822,535) in view of Moiser (US 4,492,720), and in view of Jahns (US 5,596,051) and in further view of Nelson (US 6,596,296).

9. In reference to claims 3-4, Ekman applies as above but fails to disclose the claimed second hydrogel precursor as N-isopropylacrylamide. Thus attention is directed to the Nelson reference, which discloses drug releasing biodegradable fiber implants. Specifically, Nelson discloses polymer hydrogel nanospheres loaded with biological molecules, wherein useful polymer hydrogels include N-isopropylacrylamide (NIPA). Nelson recognizes NIPA gels as having the ability to undergo dramatic volume changes of 100 fold in response to small (2-3°C) temperature change; specifically, the phase transition can be adjusted to occurs at 38-39 °C such that the nanosphere is responsive to the physiological state of the patient. The nanospheres release the drug in response to an increase in the body temperature of a patient. (Example 4 at col. 20, line 40-67). Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to include NIPA in the polymer hydrogel taught by Ekman, Moiser, and Jahns above in order to form a composition which readily releases the active core component upon a temperature change.

10. In reference to claims 5-7, it is noted that Ekman discloses these limitations. Specifically, Ekman discloses dextran as a suitable continuous phase and Ekman exemplifies utilization of

dextran with M_w of 40,000 (Example 4). Further, Ekman discloses the inclusion of water soluble salts such as magnesium sulphate which will reduce the solubility of dextran in the water (col. 2, lines 21-36). Wherein utilization of such disclosure of Ekman in the invention taught by the combination of references would be obvious to one of ordinary skill in the art.

Response to Arguments

11. Applicant's arguments filed have been fully considered but they are not persuasive.

12. Applicant has essentially argued that Jahns discloses ethylene glycol diacrylate as opposed to the claimed polyethylene glycol diacrylate and applicant has provided a declaration to prove that the two are different. The examiner agrees that the two are different, however Jahns discloses that the ethylene glycol diacrylate is polymerized and further Ekman guides one skilled in the art to have a polyethylene glycol of molecular weight 6,000. Thus the prior art provides sufficient motivation to arrive at the claimed invention.

13. Applicant has argued that polyethylene glycol is the continuous phase in Ekman, whereas applicant has claimed it to be the dispersed phase. The examiner notes that Ekman discloses that polyethylene glycol is the dispersed phase, as noted in the rejection above. As per MPEP § 2123, patents are relevant for prior art for all they contain, specifically, disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. Further patents are relevant for prior art for all they contain, specifically, a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, including nonpreferred embodiments. *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), *cert. denied*, 493 U.S. 975 (1989).

14. Thus, Ekman's disclosure of polyethylene glycol as the dispersed phase is considered prior art, and this alternative disclosure does not constitute a teaching away from any of these alternatives

because such disclosure does not criticize, discredit, or otherwise discourage the composition claimed; rather the reference reasonably teaches the limitation. Thus, the rejection is maintained and rendered valid.

15. Applicant has alleged the presence of unexpected results in the declaration; however no evidence has been provided to support these allegations as require per MPEP §716. The declaration has been considered in its entirety, but as noted above, is insufficient to overcome the rejections.

Conclusion

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SAIRA HAIDER whose telephone number is (571)272-3553. The examiner can normally be reached on Monday-Friday from 10am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James J. Seidleck/
Supervisory Patent Examiner, Art Unit 1796

Saira Haider
Examiner
Art Unit 1796